IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants:	Jay S. Walker, James A Jorasch, Dean Alderucci, Stephen C. Tulley, Peter Kim
Application No.:	09/679,186
Filed:	October 3, 2000
Title:	SYSTEMS AND METHODS WHEREIN A PLAYER INDICATES AN ITEM THAT MAY BE RECEIVED BASED ON A GAME EVENT OUTCOME ASSOCIATED WITH THE PLAYER
Att'y Docket No.:	00-033
Confirmation No.:	7415
Group Art Unit:	3714
Examiner:	D'AGOSTINO, Paul Anthony

REPLY BRIEF

BOARD OF PATENT APPEALS AND INTERFERENCES

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Appellants hereby submit remarks in this Reply Brief pursuant to 37 C.F.R. § 41.41 and in response to the Examiner's Answer mailed on July 14, 2008 (the "Examiner's Answer"). This Reply Brief is submitted as a supplement to the Appeal Brief filed on April 21, 2008(the "Appeal Brief") and should, if applicable,

be considered as a request to maintain the current appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed April 9, 2007 rejecting claims **40-74**.

REMARKS

I. No New Grounds of Rejection

Appellants note that the Examiner has, in the Examiner's Answer, not altered or added any grounds of rejection with respect to the claims being appealed. Accordingly, this Reply Brief is submitted voluntarily pursuant to 37 C.F.R. §41.41.

II. Claims 40-74 Are Patentable Over the Schneier and Nguyen Patents

Appellants incorporate by reference herein the arguments appearing on pages 40-75 of the Appeal Brief traversing the 35 U.S.C. §103(a) rejections of claims 40-74. While Appellants believe that the previous remarks incorporated by reference distinguish claims 40-74 from the cited art, provided below are further comments that address the Examiner's remarks appearing on pages 11-12 in the "Response to Arguments" section of the Examiner's Answer.

A. Nguyen Fails to Cure the Deficiencies of Schneier, and Furthermore Teaches Away From the Claimed Invention

The Examiner admits that the cited Schneier patent fails to explicitly teach receiving an indication from the player of an item that the player is interested in winning, nor teaches determining a value of the item, nor teaches arranging for the player to receive the item based on whether the total payout amount is within a

defined range of the value of the item (Examiner's Answer, page 5). Appellants also reassert that Schneier fails to disclose receiving the indication of the item that the player is interested in winning *after receiving the total payout amount information and wherein the total payout amount has not been disclosed to the player*, which subject matter appears in independent claims 40, 69, 70, 73 and 74.

Appellants also explained in the Appeal Brief that the cited Nguyen patent teaches to first provide a list of available prizes to a player, then to determine a pay table based on which prize was selected, and lastly to provide game outcomes. Thus, any game outcome is provided only ***after*** a player selected a prize (that will be awarded if the player wins). For example, the "name your prize" process described by Nguyen at col. 15, lines 3-48 and in Fig. 7 clearly explains that the selection of a pay-table by the gaming machine occurs only ***after*** a prize is selected by the player. Thus, the deficiency of Schneier noted above is not cured by that disclosed by Nguyen.

But the Examiner continues to assert that Nguyen discloses an embodiment wherein an outcome of a game occurs and then the player selects a prize, relying solely on Nguyen's disclosure at col. 6, lines 60-64 (Examiner's Answer, page11, item 10). But this portion of Nguyen merely recites:

> "Each of the prize selection tables 200 and 202 contains a number of prizes which a player may select as an award or pay-out when a certain outcome occurs during the course of a game being played on a gaming machine." (Col. 6, lines 60-64).

Appellants respectfully submit that this portion of Nguyen has been misconstrued by the Examiner. In fact, when this sentence is read in the proper context, it is clear that a player ***initially*** selects a prize as a payout from either of two prize selection tables shown in Fig. 2, and then if a certain outcome occurs

during the course of game play that player will win that prize. Appellants' interpretation is clearly correct when the cited sentence is read with the next several sentences of Nguyen, reproduced below:

> "For example, a player may select a prize, which may be won when a jackpot or maximum pay-out occurs during a slot game, video poker game, keno game or lottery game. Using one of the prize selection tables 200 or 202, a player may select prizes when an (sic.) initiating a game on the gaming machine. One or more prize selections may be made for a particular game on the gaming machine including 1) selecting an individual prize for a particular game outcome including a jackpot or some other game outcome, 2) selecting a table containing a series of prizes corresponding to a number of game outcomes, or 3) selecting multiple prizes corresponding to multiple game outcomes." (Nguyen, col. 6, line 64 to col. 7, line 9)

Accordingly, Nguyen clearly teaches a system wherein a player first selects a prize which may be won, which depends on the occurrence of a jackpot, and that the player uses the selection tables to select prizes when ***initiating*** game play.

Appellants are aware that a portion of Nguyen discloses that the player prize selection process "usually" begins before game play is initiated (see col. 7, lines 30-31), but this statement is meant to distinguish some embodiments where a prize is selected immediately after the player places a wager (which is still before game play commences, and thus before any outcome is determined). Other embodiments disclosed by Nguyen concern the value of the prize or prizes that may be selected by the player, and that the player prize selection may be combined with certain preselected prizes. But in ***all*** cases a prize is selected ***before*** game play begins and thus ***before an outcome is generated***. Nguyen specifically teaches that such operation is advantageous as it encourages game play and adds excitement for players (col. 7, lines 53-57).

In accordance with the above remarks, Appellants respectfully submit that the following conclusion reached by the Examiner is based on erroneous reasoning:

> "Since the instant invention defines the term "total payout amount" as essentially a winning outcome… and Nguyen teaches the prize selection may be made after a win (also a feature well known in the art), the amendment to claims 40, 69, 70, 73 and 74 are deemed to not patentably distinguish the instant application from Nguyen." (Examiner's Answer, page 11, item 10).

The Examiner also disagrees with Appellants arguments concerning the propriety of combining Schneier and Nguyen. However, we respectfully reassert that there is no teaching or suggestion in either Schneier or Nguyen (or otherwise supported by any evidence of record) to combine them. The Examiner points out that Nguyen mentions that the gaming machine may be a "lottery game", but there exists no indication in the record of why one skilled in the art would combine Nguyen's methodology with Schneier's off-line remote system. Furthermore, as explained above, Nguyen ***teaches away*** from the features contained in the present claims, and thus even if these references were combined, the presently claimed invention would not be the result.

Accordingly, the Examiner has failed to meet the requirements for establishing a *prima facie* case of obviousness for claims 40-74, and therefore the 35 U.S.C. §103(a) rejections cannot stand.

III. Claims 40, 69, 70, 73 and 74 Comply With the Written Description Requirement of Section 112, First Paragraph

The Examiner also states in the Examiner's Answer that his reasoning concerning the Section 112 rejections of claims 40, 69, 70, 73 and 74 were

addressed previously, which apparently references the passages appearing on pages 3 to 4 of the Examiner's Answer that repeat the rejections of the Final Action. But this statement trivializes and avoids responding to Appellants arguments found on pages 17-30 of the Appeal Brief, which arguments are incorporated by reference herein. Glaringly, the Examiner failed to address Appellants argument that each of the rejected claims is explicitly and clearly supported by the specification as filed (see Appeal Brief, pages 29-30). In fact, the Examiner has admitted as much in item 5 of the Examiner's Answer, wherein it is stated:

> "The summary of the claimed subject matter contained in the brief is correct." (Examiner's Answer, page 2, item 5).

Furthermore, the Examiner has not met the initial burden of showing why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. In particular, the term "total payout amount" is clearly defined in the specification to mean an amount of money that the player wins with regard to a total number of events. This amount of money is not disclosed to the player but is, in embodiments described in the specification, disclosed to another entity. Moreover, it is clear that the total payout amount can be received by the other entity ***before*** the player indicates an item that the player is interested in winning. In fact, just such a feature is recited by the first element of claim 40:

> *receiving from a device information regarding a total payout amount of electronic scratch-off lottery tickets stored on the device, wherein the total payout amount has not been disclosed to a player;*

Therefore, Appellants respectfully submit that the Examiner's contention that it is: "impossible to determine a total payout amount before a player makes a selection of a preferred item according to the disclosure because the total payout amount (or value of the win) is unknown until the player makes a selection" makes

no sense in the context of the pending claims. This point is reinforced when the claim as a whole is considered. In particular, the remaining elements of claim 40 recite receiving an indication from the player of an item that the player is interested in winning, determining the value of the item, and arranging for the player to receive the item based on whether the total payout amount (known to the entity) is within a defined range of the value of the item. Appellants respectfully submit that this claim language is clear and is supported by the specification as filed, and therefore that one skilled in the art would understand that Appellants were in possession of the invention as claimed as of the filing date of the application.

Accordingly, Appellants respectfully submit that the Section 112, First Paragraph rejection cannot stand.

IV. Conclusion

Appellants respectfully request that the Examiner's rejections be reversed for the reasons specified in this Reply Brief and in the Appeal Brief.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Stephan Filipek using the information provided below.

Appellants hereby request any extension of time that may be required to make this Reply Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Appellants' Deposit Account No. 50-0271.

Respectfully submitted,

September 11, 2008
Date

/Stephan J. Filipek, Reg. No. 33,384/
Stephan J. Filipek
Attorney for Appellants
Registration No. 33,384
Walker Digital Management, LLC
sfilipek@walkerdigital.com
203-461-7252 / voice
203-461-7018 / fax